



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,062	02/06/2004	Vladimir Poponin	VIRTP.002DV1C1	4803
20995	7590	09/14/2006	EXAMINER	KIM, YOUNG J
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			ART UNIT	PAPER NUMBER
			1637	

DATE MAILED: 09/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/774,062	POPONIN, VLADIMIR	
	<b>Examiner</b>	<b>Art Unit</b>	
	Young J. Kim	1637	

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 10 July 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1,2 and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 13-20 is/are allowed.
- 6) Claim(s) 1 and 2 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

The present Office Action is responsive to the Amendment received on July 10, 2006.

### ***Preliminary Remark***

Claims 3-12 are canceled.

Claims 1-2 and 13-20 are pending and are under prosecution herein.

### ***Drawings***

The drawings received on February 6, 2004 are acceptable.

### ***Information Disclosure Statement***

The IDS received on February 6, 2004 is acknowledged.

A signed copy of the PTO-1449 is enclosed herewith.

### ***Specification***

The objection to the disclosure for containing a Table of Contents, which correlates contents with a page number, made in the Office Action mailed on April 13, 2006 is withdrawn in view of the Amendment received on July 10, 2006.

### ***Claim Objections***

The objection of claims 13-20 for reciting the term, "SERS" without first identifying what the acronym means, made in the Office Action mailed on April 13, 2006 is withdrawn in view of the Amendment received on July 10, 2006.

### ***Claim Rejections - 35 USC § 112***

The rejection of claims 13 and 16 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, made in the Office Action mailed on April 13, 2006 is withdrawn in view of the Amendment received on July 10, 2006.

### ***Claim Rejections - 35 USC § 101***

The rejection of claims 13-20 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 3-10 of U.S. Patent No. 6,376,177 (herein, the '177 patent), made in the Office Action mailed on April 13, 2006 is withdrawn in view of the Amendment received on July 10, 2006.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

The rejection of claims 1 and 2 under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 2 of prior U.S. Patent No. 6,376,177 B1 (herein, '177 patent), made in the Office Action mailed on April 13, 2006 is maintained for the reasons of record.

Applicants' arguments presented in the Amendment received on July 10, 2006 have been fully considered but they are not found persuasive for the following reasons.

Applicants' arguments are addressed in the same order they were presented.

Applicants contention is that the claims of '177 patent recites that the method is drawn to detection of unlabeled DNA whereas the claims of the instant application is drawn to a method of detecting DNA, that is to say that the method is drawn to broader embodiment of DNA.

Initially, Applicants are reminded that the specification as filed does not contemplate any embodiment drawn to DNA which is labeled, but rather only the unlabeled DNAs are detected.

In addition, Applicants are reminded that the parent application which issued as the '177 patent, during prosecution, rejected the claims as being non-enabling for embodiment for labeled DNAs, and Applicants have amended to the method drawn to unlabeled DNAs.

Hence, the only enabling scope of the instant application is drawn to a method of detecting of unlabeled DNA, whether the limitation, "unlabeled" is recited in the claims or not, that is to say, that the scope of the instant claims and claims of the '177 patent is the same.

In addition, the recitation of the general term, "DNA" connotes that DNA is unlabeled.

For example, a claim drawn to an isolated DNA is distinguished from an isolated DNA which is labeled, by virtue of being separately claimed. Such clearly connotes that the general recitation of the term, "DNA" means DNA which is unlabeled.

For evidence, Applicants are referred to the following patents:

U.S. Patent No. 5,215,893 (claims 9 and 10); U.S. Patent No. 5,217,863 (claims 1 and 5); U.S. Patent No. 5,283,175 (claims 1 and 2).

The rejection is maintained therefore.

### ***Conclusion***

Claims 1 and 2 are rejected.

Claims 13-20 are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

*Inquiries*

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Young J. Kim whose telephone number is (571) 272-0785. The Examiner is on flex-time schedule and can best be reached from 8:30 a.m. to 4:30 p.m (M-W and F). The Examiner can also be reached via e-mail to [Young.Kim@uspto.gov](mailto:Young.Kim@uspto.gov). However, the office cannot guarantee security through the e-mail system nor should official papers be transmitted through this route.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. Gary Benzion, can be reached at (571) 272-0782.

Papers related to this application may be submitted to Art Unit 1637 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant does submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office. All official documents must be sent

Art Unit: 1637

to the Official Tech Center Fax number: (571) 273-8300. For Unofficial documents, faxes can be sent directly to the Examiner at (571) 273-0785. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-1600.



Young J. Kim  
Primary Examiner YOUNG J. KIM  
Art Unit 1637 PRIMARY EXAMINER  
9/11/2006

YJK